

**- - REMARKS - -**

Claims 1-49 are currently pending in the application. No amendments have been made by this response.

In the outstanding Office Action, claims 1, 2, 6-21, 23-38 and 41-49 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,946,440 to Hall (hereinafter "Hall"). Claims 1, 3-5, 22-23 and 39-40 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,389,089 to Bauer et al. (hereinafter "Bauer"). The rejections under 35 U.S.C. § 103(a) are respectfully traversed.

Independent claims 1, 23, 40 and 49 are each directed to an introducer apparatus comprising a flexible introducer member adapted to be introduced into the patient through an endoscope, a flexible sleeve having a first body portion attached to the introducer member and a second body portion moveable in response to movement of a second member sized for introduction through the introducer member. These claims further require that the second body portion of the sleeve to be eversible from a passageway of the second member such that the second member passageway is substantially unobstructed upon full deployment of the second member. Independent claim 41 is similar, and requires that a substantial part of the flexible sleeve be movably located within an interior portion of the elongated member (i.e., the inner/second member). Independent claim 48 is a method claim, and likewise requires a flexible sleeve with a substantial length of the sleeve disposed in an internal passageway of the elongated member.

As explained in Applicant's previous responses, Hall is directed to a catheter having a flexible membrane (90) that is fixedly connected between an outer tube (12) and an inner tube (16). However, and as clearly shown in Fig. 3, no portion of the membrane (90) is disposed within a passageway of the inner tube (16). To the contrary, the membrane (90) is fixedly connected to an exterior surface of the inner tube (16). Thus, Hall fails to disclose or suggest a flexible sleeve that is eversible from a passageway of a second/inner member as required by each of the independent claims. As also explained in Applicant's previous responses, Bauer likewise fails to disclose or suggest a flexible sleeve that is eversible from a passageway of a second/inner

member. As best seen in Fig. 4, the sleeve (45) is fixedly connected to the outside of the inner member (43).

Nevertheless, the Examiner has asserted that it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify either Hall or Bauer to attach the second end of the flexible member to the inside of the second member "because Applicant has not disclosed that attaching the second end of the flexible member to the inside of the second member provides an advantage, is used for a particular purpose, or solves a stated problem." Applicant respectfully disagrees.

First, there is no requirement that Applicant anticipate every difference between the invention and every prior art reference that an Examiner might conceivably rely upon during prosecution of the application, and then include in the application an explanation of any advantages the invention may provide over those differences. More specifically, there is no requirement that a patent application include speculation on the rejections an Examiner might assert and the prior art that the Examiner might rely upon. As a consequence, the Examiner cannot rely upon the absence of such speculation as demonstrating that the differences between the invention and a particular prior art reference (selected by the Examiner during prosecution) provide no advantages or are otherwise not important.

In any event, it should be pointed out that the Application provides a description of certain prior art and an explanation of at least some advantages of the invention over this art. For example, the Background of the Invention for the present application describes a urethral catheter disclosed in U.S. Patent No. 5,779,670 to Bidwell having a latex sleeve that is fixedly connected to the inside of the catheter by a sliding retention sled and to the outside of the catheter by a slidable collar. The application explains that the attachment of the sleeve to the inside of the Bidwell catheter, although suitable for use in traversing the urethra, was not suitable for other procedures and had several disadvantages that were overcome by the present invention. In particular, the application explains that certain procedures may not be completed if the sleeve remains connected to the inside of the catheter. The application further explains that "the continued presence of the sleeve over the catheter would block critical side holes" of a feeding tube or decompression catheter (p. 2 of the present application). This latter advantage is particularly relevant to Hall and Bauer, which disclose a sleeve that is

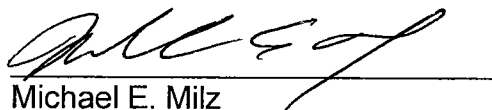
fixedly attached to the inner member in such a way that any side holes in the inner member (even though no side holes are disclosed or suggested) would be blocked by the sleeve. Thus, and contrary to the Examiner's assertion, the present application does describe the advantages of the invention over specific features of the prior art, including the features of Hall and Bauer.

Second, both Hall and Bauer disclose an arrangement wherein the sleeve is connected to the outside of the inner member. This arrangement has several disadvantages that are overcome by the present invention. One such disadvantage is that a portion of the sleeve is disposed between the inner and outer catheters, which results in an increase in the overall diameter of the combined devices. In contrast, the present invention utilizes a sleeve that is disposed within, and is eversible from, the inner catheter, which minimizes the overall diameter of the inner and outer members.

Accordingly, and for at least the reasons discussed above, independent claims 1, 23, 40, 41, 48 and 49 are patentable over the art of record. The remaining claims are each dependent on one of these independent claims. These dependent claims are therefore likewise patentable for at least the same reasons that the independent claims have been demonstrated above to be patentable. Further discussion of these dependent claims is therefore unnecessary.

It is therefore believed that the application is in condition for allowance, and such allowance is now earnestly requested. If for any reason the Examiner is not able to allow the application, he is requested to contact the Applicants' undersigned attorney at (312) 321-4273.

Respectfully submitted,

  
Michael E. Milz  
Registration No. 34,880  
Attorney for Applicant

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200